REMARKS

For the first time the Examiner rejects claims based on newly-applied U.S. Patent 6,507,567 and U.S. Patent 6,724,813. The Examiner contends that the action has been made final "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action." Applicants disagree. Many rejected claims have never been amended. For example, claims 15-23 have not been amended. The rejection of these claims based on new art was not precipitated by amendment. A final action is premature. Accordingly, withdrawal of the finality of the Office Action is respectfully requested.

Claims 1-3, 10-17, 24-26, 30-35 and 39-42 stand rejected under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent 6,507,567 to Willars. This rejection is respectfully traversed.

To establish that a claim is anticipated, the Examiner must point out where each and every limitation in the claim is found in a single prior art reference. *Scripps Clinic & Research Found. v. Genentec, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991). Every limitation contained in the claims must be present in the reference, and if even one limitation is missing from the reference, then it does not anticipate the claim. *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565 (Fed. Cir. 1986). Willars does not teach each and every feature of the rejected claims.

Regarding claims 1, 24 and 39, the Examiner appears to be equating the term "bearer" with "radio channel." These two terms are not equated in the instant application or in Willars. The Examiner's attention is directed, for example, to Figure 3 of the instant

application in which transport bearers are shown as "pipes" and relate to communicating information between nodes and a radio access network (RAN) 13. Information is communicated between the RAN 13 and the UE 22 over the air interface over a physical radio channel. Willlars also describes bearers being used to transport data through the radio access network which is then mapped on to a particular radio channel. See, for example, column 2, lines 45 through column 3, line 6. Although Willars discloses path links 1, 2, and 3 in Figure 3, there is no teaching of the establishing both the first and the second transport bearers as recited in the independent claims 1, 24, and 39. The text in Willars referred to by the Examiner in columns 8 and 9 relates to channel-type switching and not to establishing transport bearers. For example, where does this text describe establishing a "first transport bearer to transport data to be transmitted on the shared radio channel?"

But assuming that a transport bearer exists in Willars, Willars does not describe establishing the claimed "second transport bearer to transport control information originated in the CRNC relating to the first transport bearer data." Willars describes maintaining a transport bearer for an initially-established dedicated radio channel, after switching to a common type radio channel, for a predetermined period of time just in case there is a second channel switch back to a dedicated type of radio channel. While a common/shared type of radio channel transports data, Willars does not use the dedicated transport bearer to "transport control information originated in the CRNC relating to the first transport bearer data."

The lack of this claim feature is not surprising because Willars is directed to optimizing the channel based on the current quality of service and adaptively switching between different radio channel types. Claims 1, 24, and 39 are directed to a different problem, unrelated to channel switching, of delivering control information, e.g., decoding information, for the shared channel in a reliable fashion. As explained in the last Office Action, because a shared radio channel may use one of multiple radio resources based on the current radio resource scheduling by the controlling RNC, it is impractical for the mobile terminal to know and check for information regarding all the radio resources currently selected for use by the controlling RNC. Instead, the mobile terminal is informed of currently-used radio resources for the shared channel using, for example, a TFI control message. Each information can be reliably conveyed to the mobile terminal, in accordance with independent claims 1, 24, and 39, by establishing a separate transport bearer between the controlling RNC and the base station to transport controlling RNC-originated control information related to how user data will be transmitted by the base station and received by the mobile station on a shared radio channel. Figure 4, in the example embodiment, illustrates a separate transport bearer (the thick-line) between a DRNC and BS2 that conveys such information. In a configuration with only an SRNC and a base station, it may be appropriate or otherwise desirable to establish a separate transport bearer to carry such control information generated by the SRNC.

In short, Willars does not disclose generating a separate RAN transport bearer—not a radio channel—to convey information originating in the controlling RNC relating to

how user data will be transmitted by the base station and received by the mobile station on the shared radio channel.

Claims 15 and 32 recite a serving radio network controller (SRNC) separate from and coupled to a drift radio network controller (DRNC). The Examiner improperly reads the two different SRNC and DRNC on the same radio network controller 26. This is simply contrary to what is recited in claims 15 and 32. The Examiner also wrongly construes the first RAN transport bearer as transporting "the connection information from the DRNC...to the base station on the shared radio channel." To the contrary, claim 15 recites "establishing a first RAN transport bearer to transport information supervised by the SRNC [not the DRNC] for transmission over a dedicated [not common or shared] radio channel to a mobile radio unit."

In addition to the Examiner failing to point where there are two different RNCs, the Examiner also does not identify in Willars an SRNC supervising the transport of information for transmission over the dedicated radio channel and another and a drift RNC supervising transport of information for transmission over the shared radio channel. Still further, the Examiner fails to point out where in Willars a third radio transport bearer is established "to transport DRNC-originated information." If the Examiner elects to maintain this rejection, the Examiner is requested to identify in Willars the different SRNC and DRNC, each of the three different inter-RNC transport bearers, and the specific types of information/supervision associated with each one of the three bearers.

Claims 20-23 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,724,813 to Jamal. This is rejection is respectfully traversed.

Jamal describes implicit resource allocation in a radio communication system where no explicit signaling is needed to specifically identify an allocated communication resources. Instead, resources are allocated using one or more parameters known to both the radio access network and the mobile station that are more or less unique to the mobile station.

In contrast, claim 20 describes that the computer-generated data signal is communicated over a transport bearer established between a drift radio network controller and a base station, both of which are contained within a radio access network. This data signal transport does not correspond to information sent by the base station over the radio interface to a mobile station. Moreover, there is no indication where Jamal discloses that the same computer-generated data signal that includes the frame number also includes "a transport format field." None of the overhead information specifically described in the text referenced by the Examiner in columns 7 and 8 describes a signal that has both a frame number field and a transport format field.

The Examiner also highlights lines 50-53 in column 7. This text simply says that the mobile station uses the broadcast parameters "for use in the determination of an uplink scrambling code." Thus, to the extent that the Examiner is contending that a scrambling code might be conveyed in a transport format field, this text in Jamal *teaches away* from sending a scrambling code in the broadcast message. Rather, Jamal's goal is

to avoid sending the scrambling code and to have the mobile station determine the scrambling code using other information that does not relate to the scrambling code itself. There is certainly no teaching in Jamal's columns 7 and 8 that the transport field includes "information that may be used to address a transport format table stored in a mobile unit," as recited in claim 21, or a transport format combination indicator (TFCI) generated by the drift radio network controller, as recited in claim 23.

The remaining claims stand rejected under 35 U.S.C. §103 as being unpatentable over Willars in view of Jamal et al. This rejection is respectfully traversed.

First, the Willars and Jamal et al. patents are not prior art under §102(e), (f), or (g) for purposes of determining nonobviousness. As recited in 35 U.S.C. §103(c):

> subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of section 102 of this title, shall not preclude patentability of this section when the subject matter and the claimed invention were at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Here, the subject matter of both Willars and Jamal, as well as the claimed invention, were at the time the invention was made, owned by Telefonaktiebolaget LM Ericsson or were subject to an obligation of assignment to Telefonaktiebolaget LM Ericsson. Second, even if the combination of Willars and Jamal could be made, that combination fails to remedy the deficiencies already noted above.

The application is now in condition for allowance. An early notice to that effect is earnestly solicited.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____
John R. Lastova
Reg. No. 33,149

JRL:at
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100